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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,875

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Niki S. Woodhead

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EXAMINER

GARCIA, ERNESTO

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,875	<b>Applicant(s)</b> WOODHEAD ET AL.	
	<b>Examiner</b> ERNESTO GARCIA	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/21/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election of Species***

Applicant's election with traverse of species I, claims 1-4, 6, 9, and 10, in the reply filed on November 29, 2007 is acknowledged. The traversal is on the grounds that the lack of unity is based on a posteriori (e.g., knowledge derived from experience), that there is no undue burden if restriction is not required, and that the Office does not indicate that the species represent separate classifications. This is not found persuasive because posterior is not based on knowledge derived from experience but rather the known reference to Blaurock et al., US3,838,928. With regards to the undue burden, applicants have failed to show that "search" is the only criterion that goes into determining the existence of "burden" nor that a search for the non-elected species would not entail any more in the way of search queries than that currently required for the elected species. It is also not explained how a search query for protrusions extending outward from the ring will produce art for protrusions projecting inward from the ring. Is it applicants' position that this is merely an obvious reversal of parts and thus not patentably distinct from one another? If this is applicants' intent, then such must be clearly stated. To have to examine two or more patentably distinct species of

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different scope in the same application, including consideration of individual arguments for each species, clearly would impart a serious burden upon the examiner, especially when the patentability of one is not dependent upon the other. Contrary to applicants' remarks, the Office action is not contradictory. In particular, when it is stated that both species have the same special features, this is in reference to the features as broadly set forth in the independent claim, e.g., both species possess protrusions and claim 1 did not care which direction the protrusions protruded. With regard to applicants' remarks that the Office action does not indicate that the species represent separate classifications, applicants' should note that in a species election requirement there is no requirement for the species be classified in different classifications under PCT rules or, for that matter, in US practice. Thus, it would appear that applicants are confusing the requirements of a restriction between inventions with those of an election requirement between species.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5, 7, 11, and 12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

The drawings were received on August 21, 2007. These drawings are acceptable; however, not all drawing objections have been overcome.

Figures 3 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Applicants argue that these figures are not prior art. The examiner is not persuaded by the argument since the specification indicates on page 13, line 23-24, that "Figure 3 shows in cross section another known tolerance ring", and on page 14, line 5-6, "Figure 5 shows in cross section, another known tolerance ring".

The drawings are objected to because reference characters "1", "11", "13", "17", and "21" should be designated with an arrow to depict the tolerance ring as a whole. Reference character "8" in Figure 2 should point to the surface of the bore rather than the bore. Reference character "14" in Figure 4 should point to the guide portion instead of the bore 4 or the surface of the bore 4. Reference character "22" should point to the guide portion in Figure 6. Further, it has come to the examiner attention that the boundary lines of the actuator arm 5 are made with small dash lines rather than solid lines. The boundary lines should be made solid.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing

figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

Claims 1-4, 6, and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Blaurock et al., 3,838,928.

Regarding claim 1, Blaurock et al. disclose, in Figure 7, a tolerance ring comprising a band **124** of resilient material. The band has corrugated protrusions **136** extending radially in a common radial direction away from the band **124**, and a guide portion **138**. The guide portion **138** is contiguous with and extends axially from the band **124**. The guide portion **138** comprises at least one guide surface **A1** inclined relative to the axis of the band **124** in the radial direction of the corrugated protrusions **136** such

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that a free end **A2** (see marked-up attachment) of the guide portion **138** defines an opening of a size other than that **A3** (see attachment) defined by the band **124**.

Regarding claim 2, the angle of inclination of the guide surface **A1** relative to the axis is constant along the length of the guide surface.

Regarding claims 3 and 8, the guide portion **138** extends from the whole circumference of the band **124**.

Regarding claim 4, Blaurock et al. disclose, in Figure 7, an apparatus comprising a housing **126**, a shaft **128**, and a tolerance ring **124**. The housing **126** has a bore **132**. The ring **124** comprises a band of resilient material. The band has corrugated protrusions **136** extending radially in a common radial direction away from the band **124**, and a guide portion **138**. The guide portion **138** is contiguous with and extends axially from the band **124**. The guide portion **138** comprises at least one guide surface **A1** inclined relative to the axis of the band **124** in the radial direction of the corrugated protrusions **136** such that a free end **A2** (see marked-up attachment) of the guide portion **138** defines an opening of a size other than that **A3** (see attachment) defined by the band **124**.

Regarding claims 6, 9, and 10, at the outset, it should be noted that in method claims, it is the patentability of the method steps that is to be determined and not the

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recited structure. Structure not affected in the manipulative sense is given little patentable weight. Accordingly, Blaurock et al. disclose the method comprising:

inserting a tolerance ring **124** in a bore **132** in a housing **126**;

engaging the wall of the bore **132** with radially outward protrusions **136** of the tolerance ring **124**;

inserting an end of a shaft **128** into a guide portion **138** of the tolerance ring **124**;  
and,

moving the shaft **128** along the axis of the band into the band so that the band engages the shaft **128**.

### ***Response to Arguments***

Applicants' arguments filed November 29, 2007 have been fully considered but they are not persuasive.

Applicants argue that Blaurock et al. teach away from corrugated protrusions extending either radially outward from the band or radially inward toward the axis of the band and that Blaurock et al. disclose projections on both major faces. In response, the argument is not persuasive since column 1, lines 11-41, only apply to the other species disclosed, in particular to the species shown in Figure 2, and not to the species disclosed in Figure 7. Further, it should be noted that the projections themselves are not "corrugated" but rather are corrugated with respect to the recesses between the



projections. It should further be noted that claim 1 broadly sets forth protrusions that extend in a common direction away from the band and this is set forth in an open-ended manner (note the use of “comprising”). Claim 1 does not state that *all* of the protrusions on the band extend in the same direction nor does it preclude a band that has a first set of protrusions extending in one direction away from the band and a second set of protrusions extending in another direction away from the band.

Applicants further argue that Blaurock et al. do not disclose at least one guide surface inclined relative to the axis of the band such that the free end of the guide portion is wider than the opening of the band. This is not found persuasive since this is clearly taught by Blaurock et al. especially at column 4, lines 16-19. Applicants further argue that the protrusions extend in both directions. In response, it should be noted that Figure 7 does not have protrusions in both directions but rather in one direction. Feature 134 is a recess in the other direction and not a protrusion as applicants allege. Further, with respect to the remarks made to column 4, lines 51-64, teaching away from a spacer with an inclined edge portion, it should be noted that this passage does not mention anything about a tapered edge portion but rather a ring of the prior art. Furthermore, according to the previous arguments, the applicants argued that no such tapered surface is present in the reference thus it would make the previous argument invalid since this passage now mentions, as argued, an inclined edge portion not surviving repeated jamming in a gap, which is contrary to the argument that no such tapered surface is actually present.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Daniel P. Stodola/  
Supervisory Patent Examiner,  
Art Unit 3679

/E. G./

Examiner, Art Unit 3679

February 12, 2008

Attachment: one marked-up page of Blaurock et al., 3,838,928

Fig.7

